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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Hideki HISADA et al.

Group Art Unit: 2837

Application No.: 10/069,395

Examiner: T. Smith

Filed: April 3, 2002

Docket No.: 112061

For: DRIVE APPARATUS

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the February 23, 2004 Office Action, reconsideration of the above-identified application is respectfully requested. Claims 1 and 3-29 are pending.

In paragraph one of the Office Action, the Examiner asserts that the Information Disclosure Statement filed on May 20, 2002 fails to comply with 37 C.F.R. 1.97(d) because it lacks a statement as specified in 37 C.F.R. 1.97(e). This statement is not correct.

Applicants filed an Information Disclosure Statement on May 20, 2002. This date is within three months of the date of entry of the National Stage (i.e., February 26, 2002) and before the mailing of the first Office Action on the merits (i.e., August 11, 2003).

Accordingly, Applicants assert that they have satisfied both 37 C.F.R. 1.97(b)(2) and 37 C.F.R. 1.97(b)(3). Applicants do not have to satisfy 37 C.F.R. 1.97(d). In fact, an event triggering 37 C.F.R. 1.97(d) has not occurred. In other words, Applicants have yet to receive a Final Rejection, a Notice of Allowance or any action that otherwise closes prosecution in the application. Applicants do not have to provide a statement as specified in 37 C.F.R.

§1.97(e). Accordingly, it is respectfully requested that the Examiner consider the eight references submitted with the May 20, 2002 Information Disclosure Statement, the concise explanation of relevance being provided for reference one in the present specification and the concise explanation of relevance being provided for references 2-8 in the International Search Report.

Claims 1, 3, 4 and 11-29 were rejected under 35 U.S.C. §103(a) over Koide et al. (Koide), U. S. Patent No. 5,934,395 in view of the Tsuzuki et al. (Tsuzuki), U. S. Patent No. 6,018,198 and Yamaguchi et al. (Yamaguchi), U. S. Patent No. 6,546,319. The rejection is respectfully traversed.

As admitted on page 3, lines 3 and 4 of the Office Action, neither Koide nor Tsuzuki disclose causing an first electric motor to output a torque short of a torque necessary for running the engine continuously as recited in claim 1 and as similarly recited in claim 29.

Yamaguchi is disqualified as prior art under 35 U.S.C. §103(c). In particular, Yamaguchi can only qualify as prior art under 35 U.S.C. §102(e) because Yamaguchi has a filing date of May 23, 2001 and this application has an international filing date of July 11, 2001. (Applicants note that the priority document, Japanese Patent Application No. 2000-209587 was filed on July 11, 2000 which is prior to May 23, 2001.) Furthermore, both this application and Yamaguchi are both commonly assigned to Aisin AW Co., Ltd. According to 35 U.S.C. §103(c), the subject matter developed by Yamaguchi, which qualifies as prior art only under 35 U.S.C. §102(e) shall not preclude patentability under 35 U.S.C. §103 where the subject matter and the claimed invention were, at the time the invention was made, subject to an obligation of assignment to Aisin AW Co., Ltd.

Accordingly, because Koide and Tsuzuki fail to disclose all of the features recited in claims 1 and 29 as admitted in the Office Action and Yamaguchi is disqualified as prior art, it is respectfully requested that the rejection be withdrawn.

Applicants appreciate the indication of allowability for claims 5-10. However, for the reasons discussed above, Applicants assert that all of claims 1 and 3-29 are allowable.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1 and 3-29 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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JAO:SMS/sxb

Date: May 19, 2004

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